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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,055	07/21/2003	Anand Huprikar	12168	5934

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EXAMINER	
WILLIAMS, THOMAS J	
ART UNIT	**PAPER NUMBER**
3683	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/624,055	HUPRIKAR, ANAND	
	Examiner	Art Unit	
	Thomas J. Williams	3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,13-23 and 28-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13-23 and 28-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

S.O.O.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 13, 2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, 7, 9, 10, 11, 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,298,193 to Mourray.

Re-claim 1, Mourray discloses in figure 2 a mount assembly, comprising: a support structure 21 with an aperture; a carrier 65/67 is mounted in the aperture; an insulator 19 is disposed between the support structure and the carrier; the insulator has a first portion 66 with a first resistance and a first maximum width, and a second portion 63 defining a second resistance and a second maximum width, the second resistance will be greater than the first resistance (due in part to the in series compression stage design), the second width is greater than the first width, the second portion is defined by a ledge, the insulator defines an opening through the first and second portions and a base 60 extending from the opening to the ledge 63, the base abuts the support structure 21 ensuring that the first and second portions are properly compressed during

the application of forces; the carrier defines a cup that surrounds the first portion and compresses the first portion without the compressing the ledge, the cup includes a flange (interpreted as the lateral section of 65) spaced from the ledge during the application of the first force and engaging the compressing against the ledge during the application of the second force.

Re-claims 2-4, the first portion is partially compressed before the second portion is partially compressed, the first and second portions are the same material and are formed of a common homogenous material.

Re-claims 6, 7, 9-11 and 13, see figure 2.

Re-claims 14 and 15, the cup includes and inner wall 67 that extends through the aperture.

Re-claim 16, a plate 24 is mounted to a distal end of the wall.

Re-claim 17, a fastener 82 interconnects the plate with the inner wall.

Re-claims 18 and 19, a second insulator 17 is disposed between the plate 24 and the support structure 21.

4. Claims 1-4, 6, 7, 9, 10, 11 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,804,169 to Hassan.

Re-claim 1, Hassan discloses in figure 1 a mount assembly, comprising: a support structure 54 with an aperture; a carrier 42/44 is mounted in the aperture; an insulator 20 is disposed between the support structure and the carrier; the insulator has a first portion 51 with a first resistance and a first maximum width, and a second portion 50 defining a second resistance and a second maximum width, the second resistance will be greater than the first resistance (due in part to the in series compression stage design), the second width is greater than the first width,

the second portion is defined by a ledge, the insulator defines an opening through the first and second portions and a base (area adjacent the support structure) extends from the opening to the ledge 50, the base abuts the support structure 54 ensuring that the first and second portions are properly compressed during the application of forces; the carrier defines a cup that surrounds the first portion and compresses the first portion without the compressing the ledge, the cup includes a flange spaced from the ledge during the application of the first force and engaging the compressing against the ledge during the application of the second force.

Re-claims 2-4, the first portion is partially compressed before the second portion is partially compressed, the first and second portions are the same material and are formed of a common homogenous material.

Re-claims 6, 7, 9-11 and 13, see figure 1.

Re-claims 14 and 15, the cup includes and inner wall 44 that extends through the aperture.

Re-claim 16, a plate 46 is mounted to a distal end of the wall.

Re-claim 17, a fastener 26 interconnects the plate with the inner wall.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 20-23 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Mourray or Hassan in view of US 5,743,547 to Voss et al.

Re-claim 5, neither Mourray nor Hassan teach the insulator formed from a micro-cellular polyurethane. Voss et al. teach the increasing use of micro-cellular polyurethane when forming elastomeric springs or insulators. Voss et al. teach that this material has a high energy storage per weight, see column 7 lines 21-23. It would have been obvious to one of ordinary skill in the art to have manufactured the insulator of either Mourray or Hassan from a micro-cellular polyurethane as taught by Voss et al., thus providing the mount with a light weight yet efficient spring element.

Re-claim 20, Mourray and Hassan each teach the mount as recited, see above paragraphs 3 and 4. However, neither Mourray nor Hassan teach the insulator formed from a micro-cellular polyurethane and the height of the first portion relative to the second portion of the insulator, specifically the height of the first portion being at least 3 times larger than the height of the second portion.

Voss et al. teach the increasing use of micro-cellular polyurethane when forming elastomeric springs or insulators. Voss et al. teach that this material has a high energy storage per weight, see column 7 lines 21-23. It would have been obvious to one of ordinary skill in the art to have manufactured the insulator of either Mourray or Hassan from a micro-cellular polyurethane as taught by Voss et al., thus providing the mount with a light weight yet efficient spring element.

Regarding the differences in relative heights of the first and second portion. It would have been obvious to one of ordinary skill in the art as a matter of design choice through routine experimentation to have provided the first portion of either Mourray or Hassan with a height difference of at least three times that of the second portion, since applicant has not disclosed that

the recited height difference solves any stated problem or is for any particular purpose, and it appears that the insulator of either Mourray or Hassan would have performed equally well using a variety of height differences between the first and second portion, just as in the instant invention.

Furthermore, the courts have ruled that changes in shape or configuration are obvious absent persuasive evidence, see *In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)*. In addition the instant disclosure clearly states on page 6 paragraph 25 that the differences in heights between the first and second portions can vary depending upon the desired application. As such it appears that the recited height difference is not of particular importance.

Re-claims 21-23 and 28-30, the recited features are illustrated in figure 2 for Mourray, and in figure 1 for Hassan.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Mourray or Hassan.

Re-claim 8, neither Mourray nor Hassan specify the height of the first portion relative to the second portion, and more specifically that the height of the first portion is at least 3 times larger than the height of the second portion. It would have been obvious to one of ordinary skill in the art as a matter of design choice through routine experimentation to have provided the first portion of either Mourray or Hassan with a height difference of at least three (3) times that of the second portion, since applicant has not disclosed that the recited height difference solves any stated problem or is for any particular purpose, and it appears that the insulator of either Mourray or Hassan would have performed equally well using a variety of height differences between the first and second portion, just as in the instant invention.

Furthermore, the courts have ruled that changes in shape or configuration are obvious absent persuasive evidence, see *In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)*. In addition the instant disclosure clearly states on page 6 paragraph 25 that the differences in heights between the first and second portions can vary depending upon the desired application. As such it appears that the recited height difference is not of particular importance.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-11, 13-23 and 28-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 14, 15, 18-24, 27-36 and 38-47 of copending Application No. 10/619,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to have realized that the mount assembly of the instant invention is capable of use with a wheel suspension system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicant's arguments with respect to claims 1-11, 13-23 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached at 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

July 12, 2005

THOMAS WILLIAMS
PATENT EXAMINER

Thomas Williams
AU 3683
7-12-05